

5 receiving a request for a first service to be provided to the mobile communication
6 device;
7 accessing an attribute database using the received device attribute;
8 determining whether the mobile communication device is permitted to receive the
9 requested service; and
10 when the mobile communication device is determined to be permitted to receive
11 the requested service, setting up the requested service for the mobile communication
12 device. —

A3
Concl.

REMARKS

Claims 1-8 and 10 along with the new Claims 11-15 remain pending in the above-identified application. Applicants have amended Claims 1 and 6, and this amendment is not intended to overcome any application of prior art and nor is it intended to limit the scope of the claim in any manner. Applicants have added new Claims 11-15 to more clearly claim other aspects of the invention. Support for the amendments can be found within the specification. No new matter has been added. Under a separate cover new formal drawings are being submitted for review by the Examiner and the Chief Draftsperson. In view of the above amendment and the following remarks, it is respectfully submitted that all pending claims are allowable.

The rejection of Claims 1 and 4 under 35 U.S.C. §102(b) should be withdrawn

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tiedemann, Jr. et al. (U.S. Patent No. 5,629,975). Applicants respectfully submit that Claims 1 and 4 are not anticipated by Tiedemann for at least the following reasons.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984) (emphasis added). Tiedemann does not disclose each and every element of the claimed invention.

Tiedemann teaches a mobile communication device registration method. However, there is no teaching in Tiedemann for receiving device identifier for the mobile communication device via a first communication network, wherein the device identifier

provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device; accessing a device capabilities database using the received device identifier; determining whether the mobile communication device is capable of receiving the requested service; and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device, as disclosed and claimed by the Applicants in Claim 1. Thus with the Applicants' invention eligibility of service and device capabilities are determined prior to a predetermined service being provided to a mobile communication device.

In light of these facts Applicants respectfully submit that Tiedemann does not anticipate the invention of independent Claim 1.

Claim 4 depends from, and includes all the limitations of Claim 1, and therefore is not anticipated by Tiedemann.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102 (b) with respect to Claims 1 and 4 is hereby respectfully requested.

The rejection of Claims 6 and 7 under 35 U.S.C. §102(b) should be withdrawn

Claims 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fehnel et al. (PCT Patent No. WO 97/34438). Applicants respectfully submit that Claims 6 and 7 are not anticipated by Fehnel for at least the following reasons.

The above-mentioned criteria for anticipation is incorporated herein by reference and based on that criterion Fehnel does not disclose each and every element of the claimed invention.

Fehnel discloses a control channel management in cellular communication system. However, there is no teaching in Fehnel to receive a device attribute for the mobile communication device via a first communication network, wherein the device attribute provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device; accessing an attribute database using the received device attribute; determining whether the mobile communication device is permitted to receive the requested service; and when the mobile communication device is determined

to be permitted to receive the requested service, setting up the requested service for the mobile communication device, as disclosed and claimed by the Applicants in Claim 6. Thus with the Applicants' invention eligibility of service and device attributes are determined prior to any service being provided to a mobile communication device.

In light of these facts Applicants respectfully submit that Fehnel does not anticipate the invention of independent Claim 6.

Claim 7 depends from, and includes all the limitations of Claim 6, and therefore is not anticipated by Fehnel.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102 (b) with respect to Claims 6 and 7 is hereby respectfully requested.

The rejection of Claim 2 under 35 U.S.C. § 103(a) should be withdrawn

Claim 2 stands rejected under 35 U.S.C. § 103(a). The Patent Office has contended that this claim is unpatentable over Tiedemann et al. (U.S. Patent No. 5,629,975) in view of Wild et al. (U.S. Patent No. 5,862,480). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), not only must the prior art teach or suggest each element of the claim, the prior art must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F. 2d 931, 934 (Fed. Cir. 1990), cert. denied 111 S.Ct. 296 (1990); In re Bond, 910 F. 2d 831, 834 (Fed. Cir. 1990). The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See M.P.E.P. §2142. To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. See M.P.E.P. § 2143. Applicants respectfully submit that neither of these criteria for obviousness are met here.

The earlier discussion with reference to Tiedemann in connection with Claim 1 is applicable here since Claim 2 depends from Claim 1.

Wild basically discloses a method and apparatus for managing service accessibility between differing radio telecommunication networks. However, Wild in

view of Tiedemann does not cure the deficiencies of the prior art. For example, Tiedemann in view of Wild does not teach receiving device identifier for the mobile communication device via a first communication network, wherein the device identifier provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device; accessing a device capabilities database using the received device identifier; determining whether the mobile communication device is capable of receiving the requested service; and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device, as disclosed and claimed by the Applicants in Claim 1.

Similarly, Tiedemann in view of Wild does not disclose the invention of Claim 2, wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device.

Furthermore, the Patent Office has not provided any motivation for a person skilled in the art to combine Wild with Tiedemann, as Tiedemann is directed to mobile communications device registration method, while Wild is directed to managing service accessibility between differing radio telecommunication networks, and neither of them either alone or in combination disclose the invention of Claim 2, wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device.

In light of these facts Applicants respectfully submit that Tiedemann in view of Wild does not make unpatentable the invention of dependent Claim 2.

Additionally, Claim 2 depends from, and includes all the limitations of Claim 1, and therefore is not unpatentable over Tiedemann in view of Wild.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claim 2 is hereby respectfully requested.

The rejection of Claims 3 and 5 under 35 U.S.C. § 103(a) should be withdrawn

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a). The Patent Office has contended that these claims are unpatentable over Tiedemann et al. (U.S. Patent No. 5,629,975) in view of Frager (U.S. Patent No. 6,018,652). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

The earlier discussion with reference to Tiedemann in connection with Claim 1 is applicable here since Claims 3 and 5 depend from Claim 1. The above-mentioned criteria on obviousness is incorporated herein by reference

Frager is directed to a cellular telephone system having mobile charging region and area based pricing method and apparatus. However, Frager in view of Tiedemann does not cure the deficiencies of the prior art. For example, Tiedemann in view of Frager does not teach receiving device identifier for the mobile communication device via a first communication network, wherein the device identifier provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device; accessing a device capabilities database using the received device identifier; determining whether the mobile communication device is capable of receiving the requested service; and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device, as disclosed and claimed by the Applicants in Claim 1.

Similarly, Tiedemann in view of Frager does not disclose the invention of Claim 3, wherein the requested service comprises a billing plan for communications using the mobile communication device, or the invention of Claim 5, wherein the device capabilities database stores information about whether the mobile communication device is a multi-network phone and the mobile communication device is determined to be capable of receiving the service when the device capabilities database indicates that the mobile communications device is a multi-network phone, and wherein the requested service comprises a billing plan for communications using the mobile communication device.

Furthermore, the Patent Office has not provided any motivation for a person skilled in the art to combine Frager with Tiedemann, as Tiedemann is directed to mobile communications device registration method, while Frager is directed to a cellular

telephone system having mobile charging region and area based pricing method and apparatus, and neither of them either alone or in combination disclose the invention of Claims 3 and 5.

In light of these facts Applicants respectfully submit that Tiedemann in view of Frager does not make unpatentable the invention of dependent Claims 3 and 5.

Additionally, Claims 3 and 5 depends from, and includes all the limitations of Claim 1, and therefore is not unpatentable over Tiedemann in view of Frager.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claims 3 and 5 is hereby respectfully requested.

The rejection of Claims 8 and 10 under 35 U.S.C. § 103(a) should be withdrawn

Claims 8 and 10 stand rejected under 35 U.S.C. § 103(a). The Patent Office has contended that these claims are unpatentable over Fehnel et al. (PCT Patent No. WO 97/34438) in view of Frager (U.S. Patent No. 6,018,652). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

The earlier discussion with reference to Fehnel in connection with Claim 6 is applicable here since Claim 8 depends from Claim 6. The above-mentioned criteria on obviousness is incorporated herein by reference

Fehnel basically discloses a control channel management in cellular communication system. While, Frager is directed to a cellular telephone system having mobile charging region and area based pricing method and apparatus. However, Fehnel in view of Frager does not cure the deficiencies of the prior art. For example, Fehnel in view of Frager does not teach receiving a device attribute for the mobile communication device via a first communication network, wherein the device attribute provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device; accessing an attribute database using the received device attribute; determining whether the mobile communication device is permitted to receive the requested service; and when the mobile communication device is determined to be permitted to receive the requested service, setting up the requested service for the mobile communication device, as disclosed and claimed by the Applicants in Claim 6.

Similarly, Fehnel in view of Frager does not disclose the invention of Claim 8, wherein the device attribute includes a home location identifier to be associated with the mobile communication device; the attribute database including an indication of which home location identifiers correspond to geographic areas in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable, as disclosed and claimed by the Applicants.

Furthermore, Fehnel in view of Frager does not disclose the invention of Claim 10, which is a method for ascertaining whether to register a mobile communication device to a given service, the method comprising: applying a device identifier to an equipment capabilities filter; applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively, as disclosed and claimed by the Applicants.

Additionally, the Patent Office has not provided any motivation for a person skilled in the art to combine Fehnel with Frager, as Fehnel is directed to a control channel management in cellular communication system, while Frager is directed to a cellular telephone system having mobile charging region and area based pricing method and apparatus, and neither of them either alone or in combination disclose the invention of Claims 8 and 10.

In light of these facts Applicants respectfully submit that Fehnel in view of Frager does not make unpatentable the invention of Claims 8 and 10.

Additionally, Claim 8 depends from, and includes all the limitations of Claim 6, and therefore is not unpatentable over Fehnel in view of Frager.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a) with respect to Claims 8 and 10 is hereby respectfully requested.

CONCLUSION:

It is therefore respectfully submitted that Claims 1-8 and 10 along with the new Claims 11-15 are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Examiner is also invited to contact the undersigned attorney if any communication is believed to be helpful in advancing the examination of the present application.

Respectfully submitted,

Dated: JAN. 31, 2002

By: Aziz M. Ahsan

Aziz M. Ahsan
Reg. No. 32,100

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please change Attorney Docket No. to -- 12177/47501 --.

In The Claims:

Please amend Claims 1 and 6 as follows:

- 1 1. (Amended) A method for registering a mobile communication device to a service
2 comprising:
3 receiving device identifier for the mobile communication device via a first
4 communication network, wherein the device identifier provides information which the
5 mobile communication device is capable of receiving;
6 receiving, via the first network, a request for a first service to be provided to the
7 mobile communication device;
8 accessing a device capabilities database using the received device identifier;
9 determining whether the mobile communication device is capable of receiving
10 the requested service; and
11 when the mobile communication device is determined to be capable of receiving
12 the requested service, setting up the requested service for the mobile communication
13 device.
- 1 6. (Amended) A method for registering a mobile communications device to a
2 service, comprising:
3 receiving a device attribute for the mobile communication device via a first
4 communication network, wherein the device attribute provides information which the
5 mobile communication device is capable of receiving;
6 receiving, via the first network, a request for a first service to be provided to the
7 mobile communication device;
8 accessing an attribute database using the received device attribute;
9 determining whether the mobile communication device is permitted to receive the
10 requested service; and

11 when the mobile communication device is determined to be permitted to receive
12 the requested service, setting up the requested service for the mobile communication
13 device.

 Please add new Claims 11-15 as follows:

1 -- 11. (New) A program storage device readable by a machine, tangibly embodying a
2 program of executable instructions to perform a method for registering a mobile
3 communication device to a service, the method comprising:
4 receiving device identifier for the mobile communication device via a first
5 communication network, wherein the device identifier provides information which the
6 mobile communication device is capable of receiving;
7 receiving, via the first network, a request for a first service to be provided to the
8 mobile communication device;
9 accessing a device capabilities database using the received device identifier;
10 determining whether the mobile communication device is capable of receiving
11 the requested service; and
12 when the mobile communication device is determined to be capable of receiving
13 the requested service, setting up the requested service for the mobile communication
14 device.

1 12. (New) A program storage device readable by a machine, tangibly embodying a
2 program of executable instructions to perform a method for registering a mobile
3 communications device to a service, the method comprising:
4 receiving a device attribute for the mobile communication device via a first
5 communication network, wherein the device attribute provides information which the
6 mobile communication device is capable of receiving;
7 receiving, via the first network, a request for a first service to be provided to the
8 mobile communication device;
9 accessing an attribute database using the received device attribute;
10 determining whether the mobile communication device is permitted to receive the
11 requested service; and

12 when the mobile communication device is determined to be permitted to receive
13 the requested service, setting up the requested service for the mobile communication
14 device.

1 13. (New) A program storage device readable by a machine, tangibly embodying a
2 program of executable instructions to perform a method for ascertaining whether to
3 register a mobile communication device to a given service, the method comprising:

4 applying a device identifier to an equipment capabilities filter;
5 applying a home location identifier to a geographic eligibility filter; and
6 registering the mobile communication device to the given service if the device
7 identifier and home location identifier pass through the equipment capabilities filter and
8 geographic eligibility filter, respectively.

1 14. (New) A method for activating a mobile communication device to a service
2 comprising:

3 receiving device identifier for the mobile communication device, the device
4 identifier representing a type of equipment represented by the mobile communication
5 device;

6 receiving a request for a first service to be provided to the mobile communication
7 device;

8 accessing a device capabilities database using the received device identifier;

9 determining whether the mobile communication device is capable of receiving
10 the requested service; and

11 when the mobile communication device is determined to be capable of receiving
12 the requested service, setting up the requested service for the mobile communication
13 device.

1 15. (New) A method for registering a mobile communications device to a service,
2 comprising, upon activation of the mobile communications device with a service
3 provider:

4 receiving a device attribute for the mobile communication device;

5 receiving a request for a first service to be provided to the mobile communication
6 device;
7 accessing an attribute database using the received device attribute;
8 determining whether the mobile communication device is permitted to receive the
9 requested service; and
10 when the mobile communication device is determined to be permitted to receive
11 the requested service, setting up the requested service for the mobile communication
12 device. --